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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TINKLER, MURIEL S

ART UNIT PAPER NUMBER

3691

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,164

Applicant(s)

SCHOOP, RONALD

Examiner

Muriel Tinkler

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/3/2002.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This application has been reviewed. The original claims 1-9 are pending.

Rejections are as stated below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 4, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claims 1, 2, 4, and 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-9 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the claimed invention as a whole does not accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention. The mere fact that the claim performs calculating a user fee does not satisfy the requirement of 35 U.S.C. 101. The claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore is non-statutory under 35 U.S.C. § 101. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-5, 8, and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Matsumoto et al.* (US 6,230,971 B1):

Claim 1 states, "the automation device is equipped with a module for registering the operating time and/or the operations performed by the automation device in that the module is coupled to an evaluation unit for calculating a user fee accrued by the user for use of the automation device." Matsumoto states in claim 3, "A key control apparatus according to claim 1, further comprising, a time measuring unit which measures a time" and an, "electronic money processor to calculate a charge in accordance with the measured time."

Claim 3 states, "the evaluating unit is integrated with the module into a component, in that the component is equipped with a memory unit used to store an amount of operating credit and/or a reading unit for a payment card, and in that the amount of operating credit is automatically deducted in correspondence with the amount of operating time and/or the operations performed by the automation device." Matsumoto states in claim 9, "an IC card reader/writer which reads and writes the information of the IC card; an electronic money processor which processes the electronic money of the information stored in the IC card."

Claim 4 states, "the evaluation unit is equipped with a calculating unit such as a calculation table, in which the operating times and/or operations are assigned corresponding debit amounts." Matsumoto states in paragraph 49 of the detailed description, "a first charge calculating unit 38 calculates the amount of money to be charged for the use of the IC-card-operated electronic locker system."

Claim 5 states, "a safety unit, which halts operation of the automation device as soon as the stored credit has been used up." Matsumoto states in claim 17, "a

transaction is suspended at a time when a monetary deficiency is indicated by the electronic money information of the inserted IC card."

Claim 6 states, "an operating credit can be loaded into the memory unit that is integrated in the component, online through the data transmission medium." Matsumoto states in paragraph 10 under Summary of the Invention, "A corresponding amount-of-money information is then sent to the centralized management unit such as a management center via a transmission line such as a telephone circuit".

Claim 8 states, "the operating time and/or the operations performed by the automation device are registered and evaluated for calculation of a user fee, accrued by the user for use of the automation device." Matsumoto states in claim 16, "A key control apparatus according to claim 15, further comprising, a time measuring unit which measures a time after locking the key by said key controller, terminates the time measurement when coinciding the identification numbers, and causes said electronic money processor to calculate a charge in accordance with the measured time."

Claim 9 states, "the registered service data are transmitted via a data transmission medium to a central point, or are evaluated on-site in the automation device, wherein the operating time and/or the operations performed are used to calculate user fees, preferably using a calculation table, wherein a predetermined amount of credit, stored in the automation device or in the central point, or loaded using a payment card, is debited in keeping with the operating time and/or operations performed by the automation device (12, 14)." Matsumoto states in claim 15, "an identification number storing unit which stores an identification number of the

information stored in the IC card...said electronic money processor subtracts the electronic money information of the IC card.”

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto in view of Gutman et al. (US 5,221,838 A). Matsumoto discloses, “the automation device is equipped with a module for registering the operating time and/or the operations performed by the automation device in that the module is coupled to an evaluation unit for calculating a user fee accrued by the user for use of the automation device”, as shown in paragraph 5 above. Matsumoto does not disclose, “the data transmission medium is designed as a telecommunications network such as the Internet or Intranet, or as a wireless telecommunications connection such as a radio pathway.” Gutman teaches in claim 3, “means for wireless transmitting a message including financial information relating to the balance for initiating the financial transaction with the financial institution.” Therefore, it would be obvious to a person having ordinary skill in the art at the time the invention was made to modify Matsumoto as taught by Gutman to include in Matsumoto a wireless network to lower installation costs of the device at the

merchant location and/or to allow the device to be installed in a greater variety of merchant locations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HANI M. KAZIMI
PRIMARY EXAMINER